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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/042,670	Applicant(s) BENNINGHOFF, CHARLES F.
	Examiner KAREN C. TANG	Art Unit 2151

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 22 January 2008.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 23-43 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 23-43 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO/0256/06)
 Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____

5) Notice of Informal Patent Application
 6) Other: _____

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- This action is responsive to the amendment and remarks file on 1/22/08.
- Claims 23-44 are presented for further examination.

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 1/22/08 have been fully considered but they are not persuasive.

Rejection Under 35 U.S.C. 112 for Claims 23-44

Applicant argued that there's a support in Page 9, Lines 8-19, Page 23, Lines 23-30, Page 24, Lines 1-2, and Page 25, Lines 7-16 for the limitation "the encrypted hash value generated by the certifying authority after logging the recipient on to the certifying authority" and "after logging the recipient on to the certifying authority, generating by the certifying authority an encrypted hash value..thereof"

Examiner disagrees.

According to the in Page 9, Lines 8-19, Page 23, Lines 23-30, Page 24, Lines 1-2, and Page 25, Lines 7-16 of the specification, the specification in Page 9, Lines 8-19 did not explicitly indicating it is the "certifying authority" that generates the encrypted hash value. The specification in Page 23, Lines 23-30 did not indicate it is the certifying authority that generates the hash value, if any, it indicates that the Certifying authority of PoS-e posses the Camera Key. The specification in Page 24, Lines 1-2 indicates electronic certification 110, which is created by a server 100, and did not mention anything regarding certifying authority that generates the hash value.

Even if *arguendo*, in Page 9, Lines 8-19 of the specification, there was a Certifying authority that generates the hash value, this raise issues in regards to applicant's argument and response filed on 1/22/08.

Applicant, in page 9, Lines 12-13, indicates that "The present invention's Certifying Authority is not a program." Applicant further provides a definition that defines what a Certifying Authority is in page 9, Lines 5-10 "Certifying Authority is a group of PoS-e personnel...the Chief Operating Officer and the Custodian of Records."

Applicant intends to define "Certifying Authority" as "a group of PoS-e personnel". There are a few issues that are raised from the statement in applicant's response. Firstly, since the certifying authority is not a program or software but a group of personnel (i.e., a person), how can a sender be logged on to a group of personnel (see Claim 23)? Secondly, according to the remarks, on Page 9, Lines 12-13, filed on 1/22/08, Applicant admits that "Certifying Authority is not a program." It is not clear how to perform the limitation of "creating by the certifying authority...." recited in Claim 23. Specifically, it is unclear how certifying authority (i.e., personnel, not a program) can create an electronic package from inputs transmitted by sender via the public communication network (i.e., how can a person create any electronic information such as an *electronic package* without the use of software such as a *program*).

For examining purpose, "certifying authority" is being interpreted as entity/module/software.

Therefore, the 112 rejection is maintained

Rejection Under 35 U.S.C. 103 for Claims 23-44

Applicant argues that the cited art of references (Kara in view of Smith), specifically, Kara, did not teach or disclose what a Certifying Authority is since applicant indicating the present invention's Certifying Authority is not a program (refer to argument response filed on 1/22/08 page 9, Lines 12-13).

Examiner disagrees.

According to the general definition such as Patent 5,850,442: a certifying authority is a key server (refer to Col 3, Lines 46-53),

Further, Kara disclosed a certifying authority (certification system, refer to Fig 4D) and most of the limitations as stated in Claims 23-44.

Applicant further argues that Kara did not disclose the certifying authority embeds the digital certification on the face of the electronic certificate of service.

Examiner disagrees.

First, it is well known in the art that certify authority issues digital certification. It is further well known in the art that digital certification holds keys for encrypting data to send to the user (Microsoft Dictionary). Further,

In Kara, the system utilizing the checksum as the keys for encrypting data (refer to Col 4, Lines 65-66), which caused the certify authority to generate the certification indicia, along with checksum/digital certification and along with the private MK which those information are embedded on the face of the electronic certificate of service/certified encrypted electronic document, refer to Col 5, Lines, refer to Col 10, and Lines 28-30 and Col 7, Lines 8-14.)

Applicant argues that Kara did not disclose a encrypted key.

Examiner disagrees.

Since Kara does use the same scheme as applicant's invention, therefore, Kara's public and private key are the encrypted key.

Applicant argues that Kara in view of Smith, in further view of Cook did not disclose "in event that delivery was not made to the recipient within the maximum number of days, by delivering to the sender and other appropriate persons, an electronic certificate of no-service". It is understood that Kara in view of Smith, in further view of Cook, specifically Cook, has disclosed the limitation clearly. It is understood that Kara, Smith and Cook are in an analogous art. Cook, specifically indicate a predetermined number of days the system to hold the message or else it will be deleted (refer to Fig 4c and Fig 4b), further, Cook indicates that the system provides an indicators in the case when the recipients could not be located (refer to Col 15, Lines 68) the user will be informed (refer to Col 16, Lines 17) based on the predetermined amount of time.

Therefore, Kara in view of Smith, and in further view of Cook disclosed all the claimed limitations.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 23-44 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant

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art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specification does not provide information on limitations of Claim 23 (i.e., “the encrypted hash value generated by the certifying authority after logging the recipient on to the certifying authority” and “after logging the recipient on to the certifying authority, generating by the certifying authority an encrypted hash value..thereof”).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 23, 25-31, 16, 38, and 41-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kara (US 6, 297,891) in view of Smith et al hereinafter Smith (US 6,385,655).

1) Referring to Claim 23, Kara disclosed a method for verifiably transmitting an electronic package from a sender to a recipient through a certifying authority via a public communication network, the method comprising the steps of:

logging the sender on to a certifying authority (certification system/certification device/certification program, a PC 30, refer to Col 5, Lines 10-19) using a standard authentication protocol (it is obvious to have sender logon to certifying authority in order to send/check information, i.e., emails message, Col 4, Lines 54-60); creating by the certifying authority an electronic package (indicia of certification, refer to Col 5, Lines 35-43) from inputs

(cipher, refer to Col 5, Lines 32-33) transmitted by the sender via the public communications network (sender send it, refer to Col 5, Lines 15-20, a PSN, Fig 1, a public communication network); storing by the certifying authority the inputs relating to the electronic package on a server (the certified program is within PC 30, and PC 30 is a server) operated by the certifying authority for use in later verifying the inputs relating to the electronic package and storing any other data received from the sender (the certified system received the document, is a form of storing, Col 8, Lines 5 and also received a copy of the indicia, refer to Col 11, Lines 1-5 and Col 14, Lines 37); delivering a message relative to the electronic package from the certifying authority to the recipient via the public communications network (refer to Col 9, Lines 55-57); logging the recipient on the certifying authority as a response to the receipt of the message (it is obvious to have sender logon to certifying authority in order to send/check information, i.e., emails message, Col 4, Lines 54-60); generating by the certifying authority an encrypted hash value based on the inputs relating to the electronic package and the delivery thereof, the encrypted hash value uniquely identifying the particulars relating to the electronic package and the delivery thereof (MK, refer to Col 7, Lines 7-15); and transmitting an electronic certificate of service (certified encrypted electronic document) from the certifying authority via the public communications network, the electronic certificate of service including selected inputs relating to the electronic package and a digital certificate (refer to Col 10, Lines 27-31).

Although Kara disclosed the invention substantially as claimed, Kara is obvious on disclosing, "logging in the senders and logging in the recipient".

Smith, in an analogous art, discloses, "logging in the senders and logging in the recipient" (refer to Col 6, Lines 40-55).

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Hence, providing features disclosed by Smith, would be desirable for a user to implement methods that tracks the sending and receiving of a document and ways to preserves the format of a delivered document in order to provide least expense ways to reduce mis-formatted document and insure the security of the document.

Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the system of Kara by including the features provided by Kara.

- 2) Referring to Claim 25, Kara disclosed the certifying authority embeds the digital certificate on the face of the electronic certificate of service (embedded checksum and the electronic documents, refer to Col 10, Lines 28-35. refer to Col 4, Lines 65-66 and Col 7, Lines 8-14).
- 3) Referring to Claim 26, Kara disclosed wherein the certifying authority embeds the digital certificate in the electronic certificate of service electronically (embedded checksum and the document, refer to Col 10, Lines 28-35).
- 4) Referring to Claim 27, Kara disclosed wherein a recipient, sender or other person requests the certifying authority to employ the digital certificate embedded within the electronic certificate of service so as to verify that the contents of the electronic package stored on the certifying authority's server are identical to the description thereof found on the face of the electronic certificate of service (refer to Col 11, Lines 35-67, and Col 12, Lines 1-10).

- 5) Referring to Claim 28, Kara disclosed wherein the certifying authority utilizes the embedded digital certificate within the electronic certificate of service to locate and identify the electronic package (the indicia, refer to Col 11, Lines 1-5).
- 6) Referring to Claim 29, Kara disclosed wherein the certifying authority, having located and identified the electronic package, reproduce the electronic package identically to the first assembled by the certifying authority (the indicia is to find the copy of the document, Col 11, Lines 1-5 and Col 12, Lines 5-10).
- 7) Referring to Claim 30, Kara wherein the reproduced electronic package is certified to be a true and correct copy of the original electronic package, such certification being made by the certifying authority (Col 12, Lines 1-10, Col 12, Lines 34-45).
- 8) Referring to Claim 31, Kara wherein the certifying authority issues a certification to a requesting party that the reproduced electronic package is a true and correct copy of the original electronic package and said certification and electronic package are delivered to said requesting party (refer to Col 10, Lines 34-38, and Col 10, Lines 46-55, and Col 10, Lines 60-65).
- 9) Referring to Claim 36, Kara disclosed wherein comprising the steps of creating the electronic certificate of service as an encrypted file (refer to Col 4, Lines 59-67).

10) Referring to Claim 43, Kara disclosed wherein the step of transmitting an electronic certificate of service transmits an electronic certificate of service to a designee of the sender other than the recipient (send the confirmation that indicate the message is successful, refer to Col 8, Lines 20-35).

11) Referring to Claim 41, Kara disclosed wherein particulars of the inputs of the recipient that are converted to an electronic package by the certifying authority are encrypted using an encrypted key maintained solely by the certifying authority for the purpose of embedding the same into the electronic certificate of service (certification program generates MK, refer to Col 7, Lines 15-20).

12) Referring to Claim 42, Kara disclosed wherein the step of transmitting an electronic certificate of service transmits an electronic certificate of service to the recipient (refer to Col 10, Lines 50-67).

13) Referring to Claim 38, Kara disclosed verifying an encrypted hash value that is questioned by transmitting the encrypted hash value to the certifying authority; and comparing the encrypted hash value that is questioned with records of the certifying authority (refer to comparing the checksum and Col 11, Lines 45-67).

Claims 24, 32-35, 37, 39 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kara (US 6,297,891) in view of Smith et al hereinafter Smith (US 6,385,655) in further view of Cook (US 6,732,101).

14) Referring to Claims 24 and 35, Kara disclosed storing the electronic package inputs and the other related data on the server operated by the certifying authority for use in later producing a duplicate of the electronic package for a period of time agreed upon by the certifying authority and the sender (in order to sent the trusted document, the agreement must been reached prior from sending, the act of sending, is the agreement); and storing the inputs comprising: the name and address of the email sender (identification of sending site), the name and address of the recipient, the name and email of the address of any other person to whom the certification of service has been delivered, the time of delivery, the date of delivery (refer to Col 14, Lines 30-51)

Although Kara and Smith disclosed the invention substantially as claimed, Kara and Smith are silence regarding

the input comprised the subject of the message, the size of message, the electronic package retention expiration date, the name of each attachment, and the size of each attachment.

Cook, in an analogous art disclosed the subject of the message (the subject of the message (Fig _4b, Subject), the size of message (it is obvious to provide such feature, that ordinary skill in the art before the date of instant application already invented this feature, therefore, has no patentable weight), the electronic package retention expiration date (time til delete, refer to Fig 4b), the name of each attachment (attachements. 4b), and the size of each attachment (it is

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obvious to provide such feature, that ordinary skill in the art before the date of instant application already invented this feature, therefore, has no patentable weight),

Hence, providing the subject of the message, the size of message, the electronic package retention expiration date, the name of each attachment, and the size of each attachment, disclosed by Cook, would be desired for user to implement in Kara's system because it provides easier level to provide appropriate encryption engine for each different recipient that has different decryption engine.

Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to have modified the system of Kara and Smith by including the features which provides all information that certified system would need to know in order to operate accordingly to the information received.

15) Referring to Claims 32, 33 and 34, although Kara and Smith disclosed the invention substantially as claimed, Kara and Smith are silent regarding wherein the particulars surrounding the electronic package comprises maximum number of days within which to deliver the electronic package to the recipient.

Cook, in an analogous art disclosed the particulars surrounding the electronic package comprises maximum number of days within which to deliver the electronic package to the recipient (refer to Fig 4c, Number of days to hold the message).

Hence, providing the particulars surrounding the electronic package comprises maximum number of days within which to deliver the electronic package to the recipient disclosed by Cook, would be desired for user to implement in Kara and Smith's systems because it provides

easier level to provide appropriate encryption engine for each different recipient that has different decryption engine. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to have modified the system of Kara and Smith by including the features which provides all information that certified system would need to know in order to operate accordingly to the information received.

16) Referring to Claim 37, Kara disclosed wherein the step of creating the electronic certificate of service as an encrypted file (refer to Col 4, Lines 59-67), however, is accomplished by creating an encrypted PDF file that is printable but not modifiable.

17) Referring to Claim 39, although Kara and Smith disclosed the invention substantially as claimed, Kara and Smith are silence regarding notifying the recipient via the public communications network that the electronic package is available for pickup from the server operated by the certifying authority.

Cook, in an analogous art disclosed notifying the recipient via the public communications network that the electronic package is available for pickup from the server operated by the certifying authority (refer to Col 17, Lines 25-55).

Hence, providing notifying the recipient via the public communications network that the electronic package is available for pickup from the server operated by the certifying authority would be desired for user to implement in Kara and Smith's systems because it provides easier level to provide appropriate encryption engine for each different recipient that has different decryption engine. Therefore, at the time of the invention, it would have been obvious to one of

ordinary skill in the art to have modified the systems of Kara and Smith by including the features which provides all information that certified system would need to know in order to operate accordingly to the information received.

18) Referring to Claim 40, Kara disclosed wherein the step of delivering the electronic package from the certifying authority to the recipient via the public communications network (refer to Fig 1, 30 is communicate with 20 via PSN).

Although Kara and Smith disclosed the invention substantially as claimed, Kara and Smith are silent regarding the event occurs upon a request for download thereof by the recipient; and wherein the step of transmitting an electronic certificate of service from the certifying authority via the public communications network takes place after completion of the delivering step.

Cook, in an analogous art disclosed the event occurs upon a request for download thereof by the recipient; and wherein the step of transmitting an electronic certificate of service from the certifying authority via the public communications network takes place after completion of the delivering step (refer to Col 17, Lines 15-67).

Hence, providing occurs upon a request for download thereof by the recipient; and wherein the step of transmitting an electronic certificate of service from the certifying authority via the public communications network takes place after completion of the delivering step, would be desired for user to implement in Kara and Smith's systems because it provides easier level to provide appropriate encryption engine for each different recipient that has different decryption engine. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to have modified the systems of Kara and Smith, by including the features which provides all

information that certified system would need to know in order to operate accordingly to the information received.

Conclusion

Examiner's Notes: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner. In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen C. Tang whose telephone number is (571)272-3116. The examiner can normally be reached on M-F 7 - 3.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571)272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/K. C. T./
Examiner, Art Unit 2151
/John Follansbee/
Supervisory Patent Examiner, Art Unit 2151